

*REMARKS/ARGUMENTS**Applicants' Election*

Applicants elect, with traverse, the claims of Group I (claims 1-12) directed to a method of growing spermatogonial stem cells comprising culturing the cells in a medium comprising GDNF and LIF, for further prosecution. Reconsideration of the restriction requirement is hereby requested.

Discussion of the Restriction Requirement

The subject application is a U.S. national stage application based on the international application PCT/JP04/04612. The Office alleges that the inventions defined by the claims of Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.2 because they lack the same "special technical feature." Under PCT Rule 13.2, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. PCT Rule 13.2 defines the term "special technical feature" as meaning the technical feature that defines the contribution which each claimed invention, considered as a whole, makes over the prior art (see M.P.E.P. § 1893.03(d))

The claims of Groups I and IV-VIII are linked so as to form a single general inventive concept. In other words, the claims of Groups I and IV-VIII share at least one common special technical feature, which defines the contribution that each claim makes over the prior art. In this respect, the claims of Groups I and IV-VIII all recite the special technical feature of culturing spermatogonial stem cells in a medium containing GDNF and LIF.

Given the special technical feature common to the claims of Groups I and IV-VIII, the restriction requirement as between these groups of claims is not proper. In addition, a search for prior art with respect to any of Groups I and IV-VIII would likely uncover references that would be considered by the Examiner during the examination of the other groups. As a result, the Examiner would incur no undue burden in examining the claims of Groups I and IV-VIII at the same time. See also M.P.E.P. § 803 ("If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the

merits, even though it includes claims to independent or distinct inventions.” (emphasis added)).

In view of the foregoing, Applicants request that the requirement for restriction be withdrawn, if not in whole then at least in part, so that the claims of Groups I and IV-VIII are examined together.

Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Date: February 6, 2008